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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Application of :  
Neil SHANMAN et al. :  
Serial 09/294,461 : Group Art Unit - 3625  
Filed: April 19, 1999 : Examiner - Forest Thompson  
For: SYSTEM AND METHOD FOR THE :  
TARGETED DISTRIBUTION OF :  
DISCOUNT COUPONS OVER A :  
NETWORK : Docket No. S012-3653

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REPLY BRIEF

**S I R:**

Pursuant to 37 C.F.R. §1.193(b)(1), appellants present this brief in reply to the Examiner's Answer dated April 21, 2003.

At pages 5-6 of the Examiner's Answer, the Examiner acknowledged that Zip Coupons does not explicitly show that the participating retail outlets are individually selectable by the user and, in response to the selection of a retail outlet, a list of goods is transmitted as required by

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independent claims 29 and 40. However, the Examiner argued that this subject matter is inherently disclosed by Zip Coupons since the consumer selects coupons for products that he or she intends to purchase. On this basis, the Examiner concluded that it would have been obvious to modify Zip Coupons to specifically disclose that the retail outlets are individually selectable by the consumer and, in response to the selection of a retail outlet, a list of goods is transmitted for which discounts are available. The Examiner pointed out that when coupons are selected for each of the participating retail outlets as disclosed by Zip Coupons, products and retail stores are being individually selected by the consumer.

Appellants respectfully disagree. Zip Coupons merely discloses that coupons are displayed based on entry of a zip code. The downloading of a list of participating retail outlets that are individually selectable by a user, as recited by claims 29 and 40, is not expressly or inherently disclosed by Zip Coupons.

A finding of inherency requires that the above-described subject matter of independent claims 29 and 40 is necessarily disclosed by Zip Coupons. In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (rejection reversed because inherency argument was based on what would result be due to

optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 212 USPQ 323, 326 (CCPA 1981) (it must be "clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient").

Zip Coupons does not inherently disclose the display of a list of participating retail outlets, the selection of a retail outlet, and the display of a list of all goods offered for sale by the selected retail outlet. Each of these claimed elements of the present invention is necessary to construct a customized shopping list for a particular retail outlet in the claimed manner.

Instead, Zip Coupons discloses that a user enters a zip code and, in response thereto, one or more coupons are displayed. The disclosure of Zip Coupons does not inherently result in selection of a participating retail outlet as argued by the Examiner, and most certainly does not result in the downloading of a list of all goods sold by that retail outlet. Moreover, such goods are not displayed in the manner arranged in that retail outlet as further required by various rejected

claims including independent claim 40. These claimed features of the present invention do not necessarily result from the disclosure of Zip Coupons. The Examiner's inherency rejections are erroneous because the missing subject matter of Zip Coupons pertaining to the downloading of a list of participating retail outlets, the selection of a participating retail outlet, and the downloading of a list of the goods sold by that retail outlet is not necessarily present in Zip Coupons. Zip Coupons does not necessarily disclose the claimed subject matter.

Nor is the above-described subject matter inherently or expressly disclosed by the Excite reference.

The present invention provides a system and method for generating a shopping list that is customized to reflect a consumer's choice of a specific retail outlet by specifying aisle locations of goods selected for purchase by the consumer (specification, pg. 1, first full paragraph) (claims 29 and 40). The present invention also generates coupons based on the consumers selection of goods.

In accordance with the present invention, a consumer is shown one of a generic list of goods generally sold in a selected type of retail outlet or a specific list of goods sold in an actual retail outlet selected by the consumer (specification, pgs. 35-40). Once the consumer has indicated

the items he or she plans to purchase from the displayed generic or specific list, the system returns to the consumer a shopping list that is customized to indicate the aisle locations of each intended purchase within the selected retail outlet. The shopping list obtained by the present invention serves as a roadmap of the selected retail outlet so the shopper can shop more efficiently.

The personalized shopping list permits manufacturers of products sold within the retail outlet selected by the consumer to electronically generate and deliver coupons categorically matched to planned purchases by a consumer prior to a consumer's actual visit to the retail outlet.

At pages 19 and 23 of the Examiner's Answer, the Examiner acknowledged that neither Zip Coupons nor Scroggie discloses transmitting from the second computer to the first computer a file containing data identifying the physical aisle location in a selected retail outlet of goods selected by a consumer. However, the Examiner argued that Burke discloses this claimed feature of the present invention.

Appellants respectfully disagree. The claims do not recite a virtual on-line shopping system of the type disclosed by Burke, but recite the on-line generation of a customized shopping list for use at an actual retail outlet. Burke does not contemplate an actual retail outlet and discloses a

hypothetical warehouse having a hypothetical layout. Burke does not disclose the generation of a customized shopping list that a consumer may take with him or her to an actual store. Burke does not disclose the generation of any type of shopping list. The Examiner argued that the claimed customized shopping list is obvious based upon the disclosure by Burke of stored aisle numbers of goods in the Burke server for use in displaying goods in a virtual reality manner. However, such data is never provided to consumers in the form of a shopping list including aisle numbers in an actual retail outlet. The Burke "warehouse" does not exist in the physical world and no legitimate argument can be made that Burke somehow suggests the generation of a customized shopping list containing aisle numbers for use by a consumer while shopping at an actual store. Burke conveys a graphical representation of a non-existent store with shelves stocking as many as all of the 50,000 types of goods offered for sale throughout the entire country as maintained by national databases. The server of the Burke virtual store contains data identifying the virtual location of goods solely to graphically render the visual images of the hypothetical warehouse. However, the physical location data is not provided to the consumer in the form of an actual store layout and no shopping list of selected goods containing aisle numbers of the goods in the actual, selected

retail outlet is provided by Burke, as required by independent claims 29 and 40.

At page 24 of the Examiner's Answer, the Examiner argued that Scroggie discloses the transmission of a shopping list to the consumer and that Burke suggests modifying this list to identify the physical aisle number of the goods in the selected retail outlet.

As pointed out above, the Burke server contains data identifying the location of goods in its virtual reality warehouse. However, this data is never transmitted to the consumer in the form of a shopping list. Burke does not suggest modifying the Scroggie patent to provide aisle numbers or other location data in the shopping list of Scroggie.

At pages 21-22 of the Examiner's Answer, the Examiner argued that claim 29 recites, in an alternative manner, either the generation of coupons for selected goods or the generation of coupons for competitively-branded goods if coupons for the selected goods are not available. Based on this interpretation of claim 29, the Examiner argued that his finding of obviousness with respect to the generation of coupons for selected goods is sufficient to render claim 29 unpatentable even though none of the references discloses or suggests the generation of coupons for competitively-branded goods if coupons for the selected goods are not available.

The Examiner's interpretation of claim 29 is erroneous because it completely ignores the expressly recited limitations of the claim. Independent claim 29 recites that if coupons corresponding to the goods selected by the consumer are not available at the selected retail outlet, the claimed system transmits coupons for competitively-branded goods or coupons for the selected goods at another retail outlet, in addition to transmitting a personalized shopping list (independent claim 29). This aspect of claim 29 is not set forth in an "either/or" manner but is performed by the claimed invention if coupons for the goods selected by the consumer are not available in the selected retail outlet.

At pages 24-30 of the Examiner's Answer, the Examiner disputed appellants' position concerning the secondary references and argued that the combined teachings of the cited references would have suggested the invention as claimed.

Appellants respectfully submit that the prior art does not disclose or suggest the personalized shopping list containing goods selected by the consumer in a selected retail outlet along with the aisle locations of the selected goods in the selected retail outlet, as recited by each of independent claims 29 and 40.



For instance, although the Scroggie reference discloses a shopping list, the Scroggie shopping list merely provides the consumer with a list of food items needed to prepare a selected recipe along with available coupons. The personalized shopping list of the present invention contains aisle locations at any one of an unlimited number of retail outlets. Burke does not in any way suggest modifying Scroggie to include in a shopping list aisle numbers of selected goods (or competitively-branded goods) in a selected retail outlet.

By offering consumers the ability to electronically prepare an interactive shopping list over a network through keyboard entries, mouse clicks, voice commands or via virtual shopping, the claimed invention gives consumers the added benefit of a customized shopping list which directs them to their selected goods at the selected retail outlet and coupons tailored to their selection of goods. This enables consumers to obtain advanced knowledge of the aisle location of each intended purchase within their selected retail outlet and enhances shopping convenience. In addition to benefiting the consumer, the inventive system and method assists retailers in inventory anticipation and helps build customer loyalty. For manufacturers of products sold in the retail environment, the inventive system and method provides a targeted method of delivering coupons to pre-qualified customers that are

categorically matched to planned purchases, thereby avoiding the waste and inefficiency of conventional coupon distribution methods.

Among the cited references to Zip Coupons, Excite, Scroggie and Katz, only Scroggie discloses a shopping list. However, the Scroggie shopping list differs from the claimed shopping list. None of the cited references disclose the personalized shopping list of the present invention which renders the present invention markedly distinct from the prior art.

More specifically, independent claims 29 and 40 recite a system in which consumer units are provided for receiving information over a network from a server which stores and transmits files containing a list of an unlimited number of actual participating stores, including name and location, inventory of each of the participating stores and (optionally) coupon data. The claims further set forth a particular system for the distribution of a personalized shopping list showing aisle location in an actual, selected store and optionally generating coupons associated with selected goods. The claims recite the generation of a personalized shopping list along with a series of other clearly defined steps that are absent from the cited references.

More specifically, independent claims 29 and 40 require the establishment of a link between a consumer unit (which may be a computer, a television, a telephone, a handheld computer, or the like) and a server computer over a communications medium, transmitting from the server to the consumer unit a list of participating retailers, displaying the list of retailers on the consumer unit so that the consumer may select one of the displayed retailers, transmitting from the server to the consumer unit a list of the inventory of goods of the selected retailer or a list of goods generally sold by a particular type of retailer selected by the consumer and, in response to the selection of one or more items of goods by the consumer, transmitting from the server to the consumer computer a file containing a list of the selected goods identifying the aisle location of the selected goods in a selected retail outlet and transmitting coupons for the selected goods.

Independent claims 29 and 40 recite subject matter that is not disclosed or rendered obvious by the cited prior art.

Zip Coupons, either alone or in combination with one or more of Scroggie, Excite, and Katz, does not disclose a system for performing all of the following steps: (1) displaying a list of participating, individually-selectable

retail outlets; (2) displaying a list of either the inventory of goods offered for sale by a selected retail outlet or goods generally sold by a particular type of retail outlet selected by the consumer; (3) allowing the consumer to select one or more of the displayed goods; (4) providing a shopping list identifying the physical location (aisle number) of the selected goods in the selected retail outlet; and (5) generating coupons for the selected goods after the foregoing selections are made.

Step (4) above is neither disclosed nor suggested by the cited references.

Zip Coupons merely discloses the concept of targeted coupon distribution by disclosing that coupons for certain generic product categories (not retail outlets) can be accessed by a consumer based on zip code. Zip Coupons does not disclose any structure or method for the generation of a customized shopping list based on selections of goods by a consumer from a list of user-selectable goods available at a selected retail outlet.

Accordingly, Zip Coupons does not disclose or suggest the structure or steps of claims 29 and 40, each of which requires that the server transmit to a consumer unit, in response to the selection by the consumer of one of the displayed retailers, a list of the inventory of goods of a

selected retailer and displaying the list on the consumer unit.

Neither Scroggie, Excite, Katz or Burke cure the foregoing defects of Zip Coupons. The references do not disclose a system responsive to selections made from a list of participating user-selectable retail outlets and user-selectable goods to generate a customized shopping list containing a list of the selected goods and aisle locations of the selected goods at the selected retail outlet.

As noted above, Scroggie discloses the generation of a shopping list which does not contain aisle locations of selected goods in a selected retail outlet.

Excite discloses an on-line coupon generation system which offers consumers coupons based on their shopping interests. Excite does not disclose or suggest the generation of a personalized shopping list.

Katz discloses a method for on-line selection of goods. However, it does not disclose or suggest the generation of a personalized shopping list.

Claims 29 and 40 recite a system and method in which a coupon server transmits and displays on a consumer unit a file containing a list of participating retail outlets for selection of a retail outlet by a consumer and another file containing the inventory of goods sold at the selected retail

outlet (or a generic list of goods generally sold at a particular type of retail outlet). The server is responsive to consumer selections to distribute a list of selected goods identifying the aisle location of the selected goods in the selected retail outlet and optionally for distributing coupons based on the selected goods. Neither Zip Coupons, Scroggie or Excite disclose or suggest the claimed combination of structure or steps.

Independent claim 40 also relates to a system which has a server that contains data identifying an inventory of goods offered for sale and graphical data for displaying a representation of the retail outlets including a physical layout of the goods in the retail outlets. The server further contains means for transmitting to a consumer unit for display thereon a representation of a selected actual retail outlet including the physical layout of the goods in the selected retail outlet.

Accordingly, the present invention provides a personalized shopping list containing a list of goods selected by a consumer in a selected retail outlet along with the aisle locations of the selected goods in the selected retail outlet. The personalized shopping list of the present invention contains aisle locations at any one of an unlimited number of retail outlets.

Burke was cited as disclosing the claim 29 requirement for data representative of the physical layout of a retail outlet, including aisle location of goods offered for sale.

However, claim 40 recites a system which has a server that contains data identifying an inventory of goods offered for sale and graphical data for displaying a representation of the retail outlets including a physical layout of the goods in the retail outlets. The server further contains means for transmitting to a consumer unit for display thereon a representation of a selected actual retail outlet including the physical layout of the goods in the selected retail outlet. This subject matter renders claim 40 separately patentable. The Examiner relied upon Burke as disclosing this claim limitation, but failed to acknowledge the significant distinction between displaying a simulated retail outlet, as disclosed by Burke, and the representation of an actual retail outlet selected by the consumer from a virtually unlimited number of actual retail outlets, as required by claim 40.

For the foregoing reason, appellants respectfully submit that claim 40 patentably distinguishes over the prior art of record.

Appellants respectfully note that independent claims 29 and 40 recite that the file transmitted from the coupon server to the respective consumer unit in response to the selection of one or more items of goods by the consumer contains data identifying the aisle location in the selected retail outlet of the goods selected by the consumer.

Claims 29 and 40 recite a system for generating a shopping list containing selected goods available at an actual retail outlet selected by the consumer. The list containing the participating retail outlets may contain an unlimited number of actual participating retail outlets, thus enabling the inventive system and method to enable consumers over a large geographic area to obtain shopping lists customized to retail outlets in their local area, as recited by various dependent claims. The customized shopping list is transmitted to the user by the coupon server in a format which identifies the consumer's selected goods along with the aisle location in the selected actual store at which the selected goods are sold, and optionally transmits coupons for the selected goods.

Burke, on the other hand, discloses the generation of a simulated warehouse on a consumer computer, which enables consumers to purchase goods on-line. Although the server of Burke contains data specifying the physical layout of the warehouse, this data is used solely for rendering the graphics



required to implement a virtual on-line store. Burke does not disclose the transmission of a shopping list containing aisle locations of selected goods at an actual retail outlet.

According to the claimed invention, consumers do not shop at a virtual supermarket, but select goods on-line and receive a list of the selected goods along with a shopping list identifying the aisle location in the actual retail outlet at which the goods are located. The consumer physically visits the selected store after obtaining the list identifying the aisle location and optional coupons for the selected goods. This is markedly distinct from the Burke reference, in that the physical location data used by Burke is never provided to the consumer in the form of an actual store layout and no shopping list of selected goods containing aisle numbers of the goods in the actual, selected retail outlet is provided by Burke, as required by independent claims 29 and 40.

For the foregoing reasons and those set forth in appellants' main brief on appeal, appellants respectfully submit that the subject matter of claims 29-40 is patentably distinct from that disclosed in Zip Coupons, Storey, Excite,

Scroggie, Katz and Burke, and that the rejection based on these references should not be sustained.

Respectfully submitted,

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June 23, 2003

Date